

REMARKS

In response to the Notice of Non-Compliance mailed on October 24, 2007, Applicant hereby re-submits the previously filed Response to Office Action in its entirety. In that regard, Applicant understands the Examiner's contention to be that, contrary to her statement in the Office Action that "applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. ***Group I, claims 1-8 and 48-54***, drawn to a composition for protecting brain cells or improving memory..." (Page 6), only Claims 1 and 2 are under examination. As such, Applicant hereby resubmits the listing of claims wherein all of the other claims than 1 and 2 have been either withdrawn or cancelled. Specifically, in this Response, Claims 5, 8, and 53 have been listed as "Withdrawn-currently amended." Although Applicant maintains his belief that Claims 5, 8, and 53, are properly elected, in order to continue prosecution please proceed with examining only Claims 1 and 2. Accordingly, Applicant respectfully submits that this non-compliance issue has been overcome by this amendment.

Additionally, it is noted that the Notice of Non-Compliant Amendment has boxes 1. and 1.A. checked, stating that the amended paragraph of the specification does not include markings. Applicant respectfully submits that this is in error, as the one paragraph to be replaced only substitutes the word "were" for "was," at the urging of the Examiner, and that the word "was" is struck out and the word "were" is underlined. Accordingly, Applicant respectfully submits that the amended paragraphs do include markings.

As such, Applicant respectfully submits that all of the non-compliant issues have been addressed by this Response and that the application is currently in order for examination on the merits. As this response is being filed within one month of the mailing of the Notice of Non-Compliant Amendment, Applicant does not believe any extension of time fees are due; however, if any additional fee is required, please charge Deposit Account Number 19-4330. Also, if the Examiner has any further questions, concerns, or requires any additional information in order to continue prosecution of the present application, she is cordially requested to please contact Applicant's counsel at the telephone number listed below.

Summary of Office Action

In the Office Action, the Examiner acknowledged Applicant's election with traverse of Group I, namely Claims 1-8 and 48-54. The Examiner also noted that the IDS submitted on September 27, 2004 has not been considered because Applicant has not provided any references nor English translations of the references. The Examiner also objected to the specification and Claim 2 for containing minor informalities.

In regard to the substantive examination of the claims, The Examiner rejected Claims 1 and 2 under 35 U.S.C. § 112, first paragraph, for not being enabled by the specification. Further, the Examiner rejected Claims 1 and 2 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Examiner also rejected Claims 1 and 2 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Summary of Amendment

Upon entry of the present Response to Office Action, the Specification and Claims 1, 2, 5, 8, and 53 will have been amended. As such, Claims 1-8 and 48-83 remain currently pending with Claims 1, 2, 5, 8, and 53 being elected for examination. By the present amendment, Applicant submits that the rejections have been overcome and respectfully requests reconsideration of the outstanding Office Action.

Applicant's Response

1. Restriction Requirement

In the Office Action of May 18, 2006, the Examiner required the election between the eleven groups, which Applicant previously elected to proceed with the prosecution of the claims in Group I, namely Claims 1-8 and 48-54.

The Examiner further required the election of a method of extraction in Species B and an additive in Species C in the Office Action of October 5, 2006. By this response,

Applicant elects to proceed with prosecution of the invention set forth in Claims 1, 2, 5, 8, and 53. Further, Applicant has elected the method of extraction in Claim 5 in Species B and has withdrawn the additive claims 7 and 50 from Species C. To that end, Applicant has amended the claims to reflect such election.

2. Objections to the Specification and Claim 2

The Examiner objected to the specification for containing an informality in line 8 on page 11. In the present amendment, Applicant has changed the objected to word, “was,” to the suggested word, “were.” As such, Applicant respectfully submits that this objection has been overcome and should now be withdrawn.

The Examiner further objected to Claim 2 for containing an informality. By the present amendment, Applicant has changed “magnesium steerage” to properly recite “magnesium stearate.” As such, Applicant respectfully submits that this objection has been overcome and should now be withdrawn.

3. Section 112 Rejections of Claims 1 and 2

Applicant respectfully submits that Claims 1, 2, 5, 8, and 53 as currently amended meet all requirements of 35 U.S.C. § 112, and in particular are fully enabled by the specification, meet the “written description” requirement, and are definite.

Applicant’s independent Claim 1 as currently amended recites, “A composition for protecting brain cells from excitotoxicity or improving memory of a patient suffering from memory loss; said composition consisting essentially of:

an extract of *Liriopsis* tuber from about 5.0 to 500mg, wherein said *Liriopsis* tuber is selected from the group consisting of *Liriope platyphylla*, *Ophiopogon japonicus*, *Ophiopogon stolonifer*, *Mondo japonicum*, and *Liriope spicata*;

talc;

lactose; and

magnesium stearate.”

In the Office Action, the Examiner submitted that, “in view of the breadth of the claims and the lack of guidance provided by the specification as well as the unpredictability

of the art, the skilled artisan would have required an undue amount of experimentation to make and/or use the claimed invention. *Office Action*, Page 12.

Applicant respectfully submits that this rejection has been overcome by the present amendment. In particular, Applicant's independent Claim 1, as currently amended, recites the specific herbs that fall within Applicant's definition of *Liriopsis tuber*, i.e., *Liriope platyphylla*, *Ophiopogon japonicus*, *Ophiopogon stolonifer*, *Mondo japonicum*, and *Liriope spicata*. As there are now only five herbs listed, Applicant respectfully submits that undue experimentation would no longer be required to make and/or use Applicant's claimed invention. Applicant submits that this information is fully disclosed in Applicant's originally filed specification at lines 20-23 on page 4, and as such, no new matter is presented by said amendment.

Furthermore, as Claim 1 has also been amended to recite, "A composition for protecting brain cells from excitotoxicity or improving memory of a patient suffering from memory loss," Applicant respectfully submits that the breadth of the claims is no longer expansive. As such, it is now believed that an enablement rejection is no longer proper and should be withdrawn.

Secondly, the Examiner submitted that Applicant's claim was directed toward the genus, "*Liriopsis tuber*," but did not provide sufficient recitations of species within the genus to show that Applicant possessed the claimed invention at the time of filing the application. *Office Action*, Pages 12-14. Further, the Examiner submits that Applicant failed to describe which specific genus and species of *Liriopsis* is claimed as the *Liriopsis* extract. *Office Action*, Page 15.

Applicant's independent Claim 1 as currently amended recites, inter alia, "...an extract of *Liriopsis tuber* from about 5.0 to 500mg, wherein said *Liriopsis tuber* is selected from the group consisting of *Liriope platyphylla*, *Ophiopogon japonicus*, *Ophiopogon stolonifer*, *Mondo japonicum*, and *Liriope spicata*..."

By this amendment, Applicant respectfully submits that the specification and claims clearly allow persons of ordinary skill in the art to recognize what the Applicant invented.

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As such, Applicant submits that a written description rejection is no longer proper and should be withdrawn.

Finally, in regard to the indefiniteness rejection, Applicant respectfully submits that the specific genus-species of plants is explicitly recited in the amended claims thereby rendering this indefiniteness rejection moot. Further, the amounts of ingredients in the claims are total amounts and not ratios within the composition, as such, Applicant respectfully submits that the claims are definite and precise. Additionally, Applicant's amended claim 1 currently recites, "A composition for protecting brain cells from excitotoxicity or improving memory of a patient suffering from memory loss..." Accordingly, Applicant respectfully submits that the terms "protecting brain cells" and "improving memory" have been clarified by the present amendment.

For the foregoing reasons, Applicant respectfully submits that all of the § 112 rejections have been overcome or rendered moot, and as such, should be withdrawn. Applicant further submits that all of the pending claims are believed to now be in condition for allowance. Early notice to that effect is respectfully requested.

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Conclusion


Applicant respectfully submits that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 112, 102, and 103, and respectfully requests that the Examiner indicate allowance of each and every pending claim of the present invention.

In view of the foregoing, it is submitted that the § 112 rejections have been discussed and overcome by the amendments to the claims and arguments made above. As such, it is believed that Claims 1, 2, 5, 8, and 53 are now in condition for allowance.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

If any additional fee is required, please charge Deposit Account Number 19-4330.

Respectfully submitted,

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